

## **REMARKS**

### **Status of the Claims**

Upon entry of the amendment above, claims 1-4 and 6-35 will be pending, claims 1, 8, 13, 19, 21, and 34 being independent.

### **Summary of the Office Action**

As evidenced by the Examiner-initialled PTO-1449 form, the Examiner has acknowledged his consideration of two previously cited French patent documents.

At the top of page 2 of the Office action, in Section 1, claim 16 is objected to regarding a minor informality (*viz.*, a double occurrence of "wherein").

Claims 1-3, 6-8, 11-14, and 21 are rejected under 35 USC §102(b), as being anticipated by KOGERT et al. (U.S. Patent No. 3,570,149, hereinafter "KOGERT"). See Section 3, beginning on page 2 of the Office action.

Claims 4, 9, 10, 16-20, 24-26, 34, and 35 are rejected under 35 USC §103(a) as being unpatentable over KOGERT in view of LENTZ (FR 726 292). See Section 5 on page 3 of the Office action.

Claims 5 and 27-33 are rejected under 35 USC §103(a) as being unpatentable over KOGERT. See Section 6, beginning near the bottom of page 4 of the Office action.

Claims 15, 22, and 23 are rejected under 35 USC §103(a) as being unpatentable over KOGERT in view of BURT (U.S. Patent No. 6,401,364). See Section 7, beginning near the bottom of page 5 of the Office action.

### **Response to the Office Action**

#### **A. Summary of Amendment**

In the amendment above, Applicants have amended claim 16 by removing the above-mentioned informality.

In addition, the subject matter of dependent claim 5 (directed to diluting the polymer in a solvent) has been added to independent claim 1.

Similarly, the other independent method claims (*viz.*, claims 13 and 19) have been amended to add the solvent limitation.

No additional claims have been added; in fact, the total number of claims would be reduced upon entry of the amendment.

No new issue is believed to be raised, inasmuch as claim 1 has been amended only by the incorporation therein of the subject matter of claim 5. Further, although claim 5 had not additionally depended from independent method claims 13 and 19, Applicants submit that the subject matter itself had been recited and kindly requests, particularly in the interest of advancing prosecution, that the Examiner not deny entry of this amendment for that reason, and more particularly in view of the fact that the rejections themselves are characterized in the Office action as new grounds of rejection.

**B. Withdrawal of Rejections Based Upon KOGERT (Solely or in Combination)**

Applicants have read the Examiner's remarks in support of his rejections, but nevertheless believe that their claimed invention is patentably different and not obvious over the teachings of KOGERT, taken alone or in combination with LENTZ or BURT.

Accordingly, Applicants request that the rejections be withdrawn. In this regard, Applicants kindly request that the Examiner give Applicants' following arguments due consideration.

As explained in paragraphs 0006-0010 of their specification, Applicants' invention provides for a good ventilation of the foot for certain sporting activities (using a mesh material, for example), while providing, at the same time, a certain resistance to wear, such as resistance to abrasion.

Therefore, according to particular embodiment(s), only portion(s) of the upper and, perhaps, portion(s) of the sole are coated with a liquid polymer. In this regard, independent claims 1, 8, 13, and 21 specify that *a polymer layer is, or has been applied to, less than the entirety of the upper of the article of footwear of the invention*. Further, by logical implication, independent claim 19 also provides for the polymer layer being applied to less than the entirety of the upper (*i.e.*, inasmuch as the polymer is applied to the upper "to create a polymer layer having an upper edge extending along a line varying in height along a length of said upper ....")

In addition, it is important, particularly for the claimed invention, that the polymer be a *liquid polymer*. As mentioned in paragraph 0017 of their specification, a solvent is used to liquify the polymer for the purpose of the application to which the invention is directed.

**1. No less than the entirety of KOGERT's shoe is coated**

In contrast to the aforementioned claims of Applicants' invention, the *entirety* of the shoe of KOGERT is coated. In column 1, lines 54-58, KOGERT explains: "[i]n accordance with the invention, ... the whole shoe [is] coated with a cohesive polyurethane layer ...." As mentioned in column 2, lines 25-30 of KOGERT, the coating is preferably done by injection molding.

The §102(b) rejection appears to be based upon the assumption that KOGERT suggests that less than the entirety of the upper of his shoe can be coated, although Applicants are unaware of the teaching or suggestion provided by KOGERT.

Near the bottom of page 2 of the Office action, the following comment is made: "the predetermined areas are less than an entirety of the upper (where necessary can be any portion of the upper) ...."

Applicants are not certain what portion of KOGERT the aforementioned comment "where necessary ...." is based. Applicants notice in column 1, line 68 (third line from bottom),

KOGERT uses the expression "if necessary." However, this passage does not appear to relate to coating less than the entire shoe with polyurethane. Instead, this passage appears to relate to the textile layer(s) of the upper being coated (optionally) with rubber or plastic.

In fact, in KOGERT's broadest claim (claim 1), he specifies "the *entire* shoe being coated externally throughout with a cohesive polyurethane layer ...."

If KOGERT were to have contemplated coating less than the entire shoe, he certainly would not have limited his invention to coating the *entire* shoe.

While a rejection might have been presented which would have taken the position that coating less than the entire upper of KOGERT's shoe would have been obvious (*i.e.*, he could have rejected the claims for obviousness under §103(a)), but no such rejection has been made. Indeed, such a position would be 180° at odds with KOGERT's express teaching and could not be supported.

Further still, in column 1, lines 37-40, KOGERT explains that an object of the invention is that it be "watertight". Certainly, then, and consistent with his claims, the *entirety* of his shoe is intended to be coated.

See also column 1, lines 57-60: "The *whole* shoe being coated with a cohesive polyurethane layer which has substantially the same thickness over the *whole* of the outside of the shoe" (emphasis added).

An argument that KOGERT discloses --- or even suggests --- the desirability of coating less than the entirety of his shoe is directly contrary to the express disclosure of KOGERT's patent.

At least for the foregoing reasons, reconsideration and withdrawal of the rejections are requested.

**2. KOGERT's disclosure not clear that a *liquid* polymer is used**

The §102(b) rejection includes the assertion that KOGERT teaches applying a polymer in a *liquid* state. Column 2, lines 7-11 of KOGERT is cited.

Applicants respectfully submit that KOGERT's disclosure is not clear on this point. In column 2, lines 7-11, it is specifically stated that the polyurethane is applied in a compact state ("compact porous polyurethane is applied") and *not* in a liquid state as the rejection appears to have left one to assume.

In fact, the only technology which is mentioned in KOGERT, which was the state of the art at the time of the patent, is molding, with which polyurethane would be used in a "compact form", as mentioned by KOGERT, for introduction into the mold

Applicants additionally note that even if one were to assume that which is not expressly taught, *i.e.*, that a liquid polymer is used by KOGERT, the combination of KOGERT and LENTZ, on the basis of which a number of claims are rejected (*viz.*, claims 4, 9, 10, 16-20, 24-26, 34, and 35) would not appear to be compatible. That is, LENTZ, which relies upon a one-piece molded (*i.e.*, solid) piece, such as rubber, consisting of a sole 1 and a part 2, which extends around the upper.

In fact, the rejection based upon a combination of KOGERT and LENTZ is supported by the following comment: KOGERT "discloses all the limitations of the claims ... except for the polymer layer straddling the sole and upper, the polymer layer varying in height along the length of the upper, and the polymer layer rising in height along the rear of the upper."

Regarding the first of these three limitations (the polymer layer straddling the sole and upper), Applicants submit that the reliance upon the disclosure of LENTZ is misplaced, albeit perhaps inadvertently so.

That is, in LENTZ there does not appear to be a coating that straddles the sole and part of the upper. Instead, the sole 1 and a part 2, which extends around the upper 3, are made in one piece, such as from rubber, as mentioned above. Providing sole 1 and part 2 in one piece is different from applying a layer to the sole and a part of the upper 3 and, particularly, a liquid layer regarding the method claims.

Further, because KOGERT already coats the *entirety* of his shoe with polyurethane, Applicants submit that it would not be logical to one skilled in the art to rely upon LENTZ as providing a suggestion that a polymer could be used to straddle the connection between the sole and the upper. That is, such additional coating would be unnecessary.

In fact, KOGERT already mentions (column 1, lines 61-63) that the junction of the sole and upper is made water-tight by virtue of the polyurethane coating.

Further, in parent claims 1, 8, and 13, the coating is a *liquid* coating. This coating, then, is quite different from a *solid* rubber sole 1/part 2 within which the upper 3 is adhesively affixed (lines 43-47 of LENTZ).

**3. KOGERT's disclosure does not teach or suggest "drying the article of footwear" limitation of claims 1, 13, and 19**

Neither KOGERT nor the combination of KOGERT and LENTZ teach or suggest a method of manufacturing an article of footwear which includes the limitation "drying the article of footwear," which appears in independent claims 1, 13, and 19.

The only method described by KOGERT in detail (column 2, lines 35-39) is a *molding* process (for which no solvent would be used) and for which a desiccant would be used to guarantee that the polyurethane granules are dry.

Hence, there would be no need to dry the article of footwear after molding as there is no solvent to evaporate. This is completely different from Applicants' claimed method in which the polymer, such as polyurethane, is diluted in a solvent and which can be applied at room temperature.

Although "applying the polymer by spraying or painting" is mentioned by KOGERT, there is no description of such a process, the only description being the aforementioned molding process.

It is also stated in KOGERT (column 1, lines 22-23) that the polyurethane is applied hot. Hence, there is no hint in KOGERT that the polyurethane can be applied in a liquid form, diluted in a solvent, which, as mentioned above, can be done at room temperature.

**4. Use of mesh material with KOGERT's disclosure would not have been obvious**

In Applicants' claims 11, 12, 14, 15, 22, and 23, they specify that the upper comprises a mesh material, or a three-dimensional mesh material.

Of the rejected claims, claims 11, 12, and 14 are rejected as being anticipated by KOGERT.

A mesh is a net-like woven material. A textile layer is not necessarily a mesh. This is even more true regarding a three-dimensional mesh material. Further, it is even possible that a three-dimensional mesh material, as such, did not exist at the time of the KOGERT patent.

**5. The use of an "aeratable" material is neither taught by KOGERT nor obvious**

In Applicants' independent claims 13, 19, 21, and 34, they specify that the upper comprises an aeratable material.

KOGERT makes clear that the entirety of his shoe is to be made waterproof: "Due to this uniform coating, absolute water-tightness is guaranteed even at the position of the junction of the sole with the upper ...." (column 1, lines 61-63, for example).

Therefore, Applicants submit, there would be no reason to have it be "aeratable", as specified in Applicants' claims.

In the passage cited in the rejection, it is suggested that the layer of polyurethane should be porous in order *to reduce the weight*, and the passage of heat (likely the idea is to make the part more insulative by adding air therein). This passage also seems to address the problem of *cushion inserts* (see column 2, lines 1-2) inserted within the shoe and not the upper itself.

**6. KOGERT fails to disclose elastically compressible air space between layers of the upper**

In Applicants' claims 14 and 23, they specify an upper comprising an elastically compressible air space between a pair of spaced apart layers.

KOGERT fails to teach or suggest this. Multiple layers of textile will certainly not necessarily be elastically compressible due to air space between layers. Multiple layers in a laminate are usually glued or otherwise attached together.

**SUMMARY AND CONCLUSION**

The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.


A check is enclosed for payment of a fee for an extension of time for one month. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.



Further, although an extension of time for a single month is believed to be necessary at this time, if it were to be found that an extension of time for additional month(s) were to be necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) that, in such event, would render this reply timely and/or complete, and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
Gérald DELGORGUE et al.

  
James L. Rowland  
Reg. No. 32,674

April 30, 2004  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191

703-716-1191 (telephone)  
703-716-1180 (fax)